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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,831	10/11/2001	Kamal Acharya	122118-175973	3000
60172 7590 02/28/2011 SCHWABE, WILLIAMSON & WYATT, P.C. 1420 FIFTH AVENUE, SUITE 3400 SEATTLE, WA 98101-4010				
EXAMINER				
DUNHAM, JASON B				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
02/28/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/975,831

Applicant(s)

ACHARYA ET AL.

Examiner

JASON B. DUNHAM

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 7, 8, 10, 11, 14, 18-20, 22 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 7, 8, 10, 11, 14, 18-20, 22 and 26-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 27, 2010 has been entered. Applicant amended claims 1, 3, 7-8, 10-11, 14, 18-20, and 22, canceled claims 23-25, and added new claims 26-31. Claims 1, 3, 7-8, 10-11, 14, 18-20, 22, 26-31 are pending.

Response to Amendment

The affidavit filed on April 27, 2010 under 37 CFR 1.131 is sufficient to overcome the McGlinn reference. Applicant's arguments, filed April 27, 2010, with respect to the rejections of the claims filed July 17, 2009 under 35 U.S.C. 103(a) in view of McGlinn have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Porat (US 2002/0026353).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Referring to claim 22. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claim 22 fails to recite a computer program that is embodied on a statutory computer-readable medium, as the medium may merely be directed to non-statutory carrier waves or signals. The Examiner recommends amending the claim to recite a "non-statutory computer-readable medium" to overcome this rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 7-8, 10-11, 14, 18-20, 22, 26-31 rejected under 35 U.S.C. 102(e) as being anticipated by Porat (US 2002/0026353).

Referring to claim 1. Porat discloses method for providing an integrated list of providers, comprising:

determining identities of at least one online provider of an item (abstract);

determining identities of at least one brick and mortar provider of the item
(paragraph 11);

integrating, by a first computer system, the identities of the at least one online provider with the identities of the at least one brick and mortar provider into an integrated list of providers of the item (figure 5 and paragraph 40); and

transmitting the integrated list of providers of the item from the first computer system to a user device, wherein the identities of the at least one online provider are distinguished from the identities of the at least one brick and mortar provider in the provided integrated list (figure 1 and paragraphs 53-54).

Referring to claims 14 and 26. Porat further discloses a method comprising: providing comparison information regarding at least two brick and mortar providers and at least one online provider and at least one brick and mortar provider to the user device (figures 5 and 10 and paragraph 54).

Referring to claims 18-20, 7-8, 10-11, and 27. Porat further discloses a method wherein the comparison information includes coupon availability information, information related to a proximity to the at least two brick and mortar providers, directions to the at least two offline providers, price, rating, availability, and special promotion comparison information, user reviews, and electronic wallet, return policy, in store return and pickup policies of online purchase, and promotions and coupon availability information (figures 1 and 10 and paragraphs 11 and 54). The examiner notes that the type of comparison information (user reviews, electronic wallet, etc.) is non-functional descriptive material. Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate- In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II.

Referring to claims 28-29. Porat further discloses a method comprising: determining whether a request for an integrated list is associated with a target geographical area or proximity to the area; and providing the integrated list based on

the determination of whether the request for the integrated list is associated with the target geographical area or the proximity (paragraph 54).

Referring to claims 22, 30, and 31. Medium claim 22 and apparatus claims 30 and 31 are rejected under the same rationale set forth above in the rejection of method claim 1 containing similar limitations.

Referring to claim 3. Porat further discloses an apparatus wherein the request for product information includes an indication of a request product category (paragraph 61).

Conclusion

The prior art made of record and not relied upon (Hicks) is considered pertinent to applicant's disclosure and cited on the attached pto-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason B Dunham/
Primary Examiner, Art Unit 3625